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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,781	12/03/2004	Silvio Aime	B-0459 US	5696
31834	7590	08/14/2009		
BRACCO RESEARCH USA INC. 305- COLLEGE ROAD EAST PRINCETON, NJ 08540			EXAMINER	
			JONES, DAMERON LEVEST	
			ART UNIT	PAPER NUMBER
			1618	
MAIL DATE	DELIVERY MODE			
08/14/2009	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/516,781	<b>Applicant(s)</b> AIME ET AL.
	<b>Examiner</b> D L. Jones	<b>Art Unit</b> 1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 27 April 2009.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-5,7-9,11-13 and 17-19 is/are pending in the application.
  - 4a) Of the above claim(s) 7-9, 11, 12, and 17-19 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 and 13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

### **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of the amendment filed 4/27/09 wherein claims 1 and 4 were amended and claims 6, 10, and 14-16 were canceled.

**Note:** Claims 1-5, 7-9, 11-13, and 17-19 are pending.

### **RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS**

2. The Applicant's arguments and/or amendment filed 4/27/09 to the rejection of claim made by the Examiner under 35 USC 102 and/or 112 have been fully considered and deemed persuasive the reasons below. In particular, all outstanding rejections are WITHDRAWN because Applicant has amended the claims to overcome the rejection. Therefore, the search was once again been expanded.

**Note:** As stated in the previous office action, initially, Applicant's elected species was searched. However, the prior art has once again been expanded to the species disclosed in Gozzini et al (US Patent No. 6,719,958) as set forth below. The search was not further expanded because prior art was once again cited against the instant invention.

### **WITHDRAWN CLAIMS**

3. Claims 7-9, 11, 12, and 17-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention/species.

### **NEW GROUNDS OF REJECTION**

#### **103 Rejection**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gozzini et al (US Patent No. 6,719,958).

**Gozzini et al** disclose polychelant compounds capable of being complexed with metal ions (see entire document, especially, abstract; columns 27-30, claims 1-5, 12, and 13). The polychelants have Formula I (see column 5, line 15, through column 8,

line 19),  $L[NH_2]_p[NHF]_z[N(F)_2]_x$  wherein K is a polychelant such as EDTA, DTPA, BOPTA, EOB-DTPA, DOTA, etc. (column 5, lines 28-31; column 6, lines 9-11) and L may be spermidine (column 5, line 59; column 11, lines 45-50). The chelant may be conjugated to bi- or trivalent ions of atomic numbers 20-31 and 57-83 (Note that atom numbers 25, 26, 63, 64, and 65 are Mn, Fe, Eu, Gd, and Dy, respectively) [column 6, lines 9-18]. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a composition comprising a spermidine (the variable N and m = 1); multiple chelating moieties (the variable D and p = 4); and no spacer group (the variable S and n = 0) since Gozzini et al disclose polychelant compounds capable of being complexed with a metal that encompass the instant invention. Hence, both Applicant and Gozzini et al disclose overlapping subject matter.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D L. Jones whose telephone number is (571)272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D L. Jones/  
Primary Examiner  
Art Unit 1618

August 12, 2009